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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/494,240	01/30/2000	Bill J. Pope	6056P	3185

7590 10/03/2002

Daniel P McCarthy  
PARSONS, BEHLE, & LATIMER  
201 SOUTH MAIN STREET, SUITE 1800  
P.O. BOX 458898  
Salt Lake City, UT 84145-0898

EXAMINER

PELLEGRINO, BRIAN E

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/494,240

Applicant(s)

POPE ET AL.

Examiner

Brian E Pellegrino

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 80-122 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 80-122 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When new claims are presented, they must be numbered *consecutively* beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 98-124 have been renumbered as claims 97-122. Additionally, the dependency for each renumbered claim has been changed to correct the recitations for antecedent basis. Renumbered claims 110,111,120 are objected to because of the following informalities: the claims depend from canceled claims and it is also unclear as to which claim applicant intended each of these to depend from. Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 80-122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buechel et al. (5702448) in view of Frushour (5011515). Fig. 1 of Buechel shows a

Art Unit: 3738

femoral head 18 having a convex articulating surface. Buechel et al. disclose a prosthetic device with a smooth articulating surface having a substrate coated with diamond, col. 10, lines 27-42 and col. 11, lines 1-4. Buechel also discloses to polish the coating, col. 8, lines 47-49 and col. 9, lines 23-25. See col. 6, lines 37-56 for metals used for the substrate. Buechel et al. additionally disclose that CoCr can be used as the metal, col. 10, lines 57-58. It is inherent that the materials have CTEs and moduli that are different. The coating formed on the substrate is crystalline in structure, col. 8, lines 1-2 and can be interpreted to include interstitial spaces in diamond layer since it has "pores" lines 4-6. It is also inherent that some  $sp^3$  bonds are formed in the coating process, well known in the art, i.e. sintering. However, Buechel does not disclose a transition zone between the substrate and the diamond or to have substrate surface topographical features. Frushour teaches that composites of diamond joined with metal substrates used in applications *requiring high abrasion resistance* are attached by high temperatures and pressure, col. 1, lines 9-16. Frushour also teaches to use irregularities in the substrate surface to increase the surface area for bonding, col. 3, lines 13-21. Frushour additionally teaches the topography can be established prior to sintering, col. 4, lines 63-67. It would have been obvious to one of ordinary skill in the art to use the method of joining diamond with a substrate and have a transition zone as taught by Frushour in the femoral head of Buechel such that the attachment is more stronger.

***Terminal Disclaimer***

The terminal disclaimer filed on 6/27/02 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6,290,726 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Response to Arguments***

Applicant's arguments with respect to new claims 80-122 have been considered but are moot in view of the new ground(s) of rejection. Regarding the Buechel reference, whether or not a product is patentable, depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. In re Klug, 333 F2d 905, 142 U.S.P.Q. 161 (CCPA 1964).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 3738

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

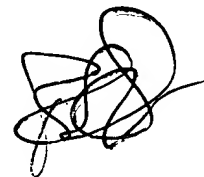
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached on Monday-Thursday from 8am to 5:30pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Brian E. Pellegrino  
TC 3700, AU 3738

September 30, 2002



Bruce Snow  
Primary Examiner

